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10/717,183	11/19/2003	Tom Carhart	SRNDP001	5977

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EXAMINER	
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ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/717,183	CARHART ET AL.	
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *10 and 22-45* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/13/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application filed November 19, 2003.

2. Claims 1-42 are pending. Claims 1-9 and 11-21 have been examined. Claims 10 and 22-45 are subject to restriction and/or election requirement. Claims 1, 14 and 20 are independent claims.

Priority

3. The priority date considered for this application is November 19, 2003.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed April 23, 2004.

Information Disclosure Statement

5. The Office acknowledges receipt of the Information Disclosure Statement filed December 13, 2004. It has been placed in the application file and the information referred to therein has been considered.

Drawings

6. The drawings filed November 19, 2003 are accepted by the examiner.

Election/Restrictions

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9 and 11-21, drawn to a method for providing a personal media service, classified in class 725, subclass 46.

II. Claims 1+10 and 22-27, drawn to a method for presenting information about media content comprising converting data to speech, classified in class 704, subclass 260.

III. Claims 28-42, drawn to a method of downloading media content, classified in class 369, subclass 1.

IV. Claims 43-45, drawn to a method for customization a personal media service comprising converting tree structure into a linear playlist, classified in class 715, subclass 727.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j).

In the instant case,

the inventions as claimed in Groups I and II have mutually exclusive characteristics (i.e., invention as claimed in Group I which relates to a method for providing a personal media service and that as claimed in Group II which relates to a method for presenting information about media content comprising converting data to speech are independent and distinct since they are classified in different classes and subclasses;

the inventions as claimed in Groups I and III have mutually exclusive characteristics (i.e., invention as claimed in Group I which relates to a method for providing a personal media service and that as claimed in Group III which relates to a method of downloading media content are independent and distinct since they are classified in different classes and subclasses;

the inventions as claimed in Groups I and IV have mutually exclusive characteristics (i.e., invention as claimed in Group I which relates to a method for providing a personal media service and that as claimed in Group IV which relates to a method for customization a personal media service comprising converting tree structure into a linear playlist are independent and distinct since they are classified in different classes and subclasses;

Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to

timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

For compact prosecution purposes, claims in Group I which are classified in class 725, subclass46 have been examined.

Specification

8. The specification is objected to because of the following minor informalities:

a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

b. The U.S. Patent Application No. of the co-filed application should be provided at page 1.

c. The use of trademarks, such as SmartPhone (p. 8, line 8) and Bluetooth (p. 10, line 10) has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to

prevent their use in a manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

i. capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., ™ or ®, as appropriate;

ii. use each trademark as an adjective modifying a description noun. For example, it would be appropriate to recite "the JAVA platform" or "the JAVA programming language." Note that in these examples, "platform" and "programming language" provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 7-9, 11-12, 14, 16-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,421,717 to Kloba et al. ("Kloba").

Claim 1

Kloba discloses at least *a method for providing a personal media service, said method comprising:*

providing a user with a selection of pre-defined channels (see at least FIG. 1C, step 1608; FIG. 5A, steps 508, 512, 514, 518, 520, 522; FIG. 5B, step 524; FIG. 5C, steps 540, 542, 544, 585, 587)*;*

storing, in a local cache, media content of at least two pre-defined channels provided by a remote publisher (see at least FIG. 1C, step 160E; FIG. 5A, steps FIG. 585, 587);

receiving input from said user specifying a custom channel as a combination of at least two pre-defined channels of said selection (see at least FIG. 1C, step 160G; FIG. 5C, step 540, 542, 544; FIGs. 46-47; FIG. 5A, steps 512, 514, 516, 518; FIG. 5B, steps 585; FIG. 5L, 5M)*; and*

wherein play of said custom channel and both of said least two-predefined channels provided by said remote publisher is immediately available from said local cache (see at least Abstract; note that operating off-line means that the content is stored on the handheld device, is thus immediately available to the user when needed without connecting to any server; FIG. 1C, "User surfs Web off-line by reading cached pages").

Claim 2

The rejection of base claim 1 is incorporated. Kloba further discloses *wherein playing said cached media content of said custom channel comprises: playing interleaved media content of said at least two pre-defined channels that have been combined into said custom channel* (see at least FIG. 1M, "Music," Movies," etc.; 17:1-3).

Claim 3

The rejection of base claim 1 is incorporated. Kloba further discloses *wherein providing said user with a selection of pre-defined channels comprises: displaying a list of said pre-defined channels* (see at least FIG. 1C, step 160D).

Claim 4

The rejections of base claim 1 and intervening claim 3 are incorporated. Kloba further discloses *wherein receiving input from said user comprises:*

dragging icons from said list representing first and second pre-defined channels to a screen area used to configure said custom channel (see at least FIG. 44, e.g., "drag the AvantGo AutoChannel).

Claim 5

The rejections of base claim 1 and intervening claims 3-4 are incorporated. Kloba further discloses *wherein upon playing of said custom channel, content from said first and second pre-defined channels are given substantially equal time* (see at least 18:18 – 19:14).

Claim 7

The rejection of base claim is incorporated. Kloba further discloses *wherein at least one of said pre-defined channels of said selection comprises content owned by said user* (see at least FIG. 14, e.g., "Personal Channels").

Claim 8

The rejection of base claim 1 is incorporated. Kloba further discloses *wherein at least one of said pre-defined channels of said selection comprises content broadcasted via Internet* (see at least FIG. 1AB).

Claim 9

The rejection of base claim 1 is incorporated. Kloba further discloses *wherein at least one of said pre-defined channels of said selection comprises content broadcast via airwaves* (see at least FIG. 30)

Claim 11

The rejection of base claim 1 is incorporated. Kloba further discloses *sending information specifying content of said custom channel via a network* (see at least FIG. 30).

Claim 12

The rejection of base claim 1 is incorporated. Kloba further discloses *transmitting media content of said local cache to a remote location via a network upon receipt of authentication information from said remote location* (see at least FIG. 1S, steps 192G-I; FIGs.28-29).

Claim 14

Kloba discloses at least *a method for providing a personal media service, said method comprising:*

providing a user with a group of pre-defined channels (see at least FIG. 1C, step 1608; FIG. 5A, steps 508, 512, 514, 518, 520, 522; FIG. 5B, step 524; FIG. 5C, steps 540, 542, 544, 585, 587)*;*

accepting a user selection of at least two of said pre-defined channels (see at least FIG. 1C, step 160G; FIG. 5C, step 540, 542, 544; FIGs. 46-47; FIG. 5A, steps 512, 514, 516, 518; FIG. 5B, steps 585; FIG. 5L, 5M)*; and*

selecting supplemental media content to interleave with media content of said at least two selected pre-defined channels (see at least FIG. 1C, step 160G; FIG. 5C, step 540, 542, 544; FIGs. 46-47; FIG. 5A, steps 512, 514, 516, 518; FIG. 5B, steps 585; FIG. 5L, 5M)*; and*

caching said selected supplemental media content along with said two pre-defined channels to make available for immediate play (see at least FIG. 1C, step 160E; FIG. 5A, steps FIG. 585, 587)*;*

playing media content of a first one of said selected pre-defined channels interspersed with said supplemental media content (see at least Abstract; note that operating off-line means that the content is stored on the handheld device, is thus immediately available to the user when needed without connecting to any server; FIG. 1C, "User surfs Web off-line by reading cached pages").

Claim 16

The rejection of base claim 14 is incorporated. Kloba further discloses

receiving from said user information about user preferences (see at least 5A, step 518; e.g., the user preferences being the selected category; FIG. 5B, e.g., step 585); *and*

selecting said supplemental media content based on said user preferences (see at least 5A, step 520; FIG. 5B, step 587).

Claim 17

The rejection of base claim 14 is incorporated. Kloba further discloses *after playing first selected channel interspersed with said supplemental media content, playing said second selected channel interspersed with said supplemental media content while continuing to advance through said supplemental media content* (see at least FIG. 1M, "Music," Movies," etc.; 17:1-3).

Claim 18

The rejection of base claim 14 is incorporated. Kloba further discloses *wherein selecting said supplemental media content comprises selecting based on a current location of a portable device* (see at least FIG. 31, "Location:".

Claim 19

The rejections of base claim 14 and intervening claim 18 are incorporated. Kloba does not specifically disclose *determining said current location employing GPS*. However, this feature is deemed inherent to Kloba since Kloba enables web content to be loaded on mobile devices (1:61-67) similar to an Internet enabled mobile telephone with a GPS receiver disclosed in WO-2001-063317, wherein the GPS receiver may be arranged to power up in response to the user selecting a particular web site, for example, a website associated with a location based service whereby the call location is determined in anticipation of a request from that website. Without the GPS, the mobile phone could not be located so that the web content could be downloaded to the mobile phone.

Claim 20

Kloba discloses at least *a method of providing a personal media service, said method comprising:*

receiving a series of preferences from a user (see at least FIG. 5A, steps 514, 518);

applying rules to said preferences to identify a list of pre-defined channels available to said user (see at least FIG. 5A, steps 520, 516);

displaying said list of pre-defined channels to said user (see at least FIG. 1C, step 1608; FIG. 5A, steps 508, 512, 514, 518, 520, 522; FIG. 5B, step 524; FIG. 5C, steps 540, 542, 544, 585, 587); *and*

locally caching at least two of said pre-defined channels so that either is available for immediate play (see at least FIG. 1C, step 160E; FIG. 5A, steps FIG. 585, 587).

Claim Rejections – 35 USC § 103

11. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not negatived by the manner in which the invention was made.

12. Claims 13, 15 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,421,717 to Kloba et al. ("Kloba").

Claim 13

Kloba does not specifically disclose:

based on user input, developing information specifying a media content type to be recorded;

monitoring content of one of said pre-defined channels;

analyzing said content to capture a content identification signature; and

recording and preserving said content for later play only if said content identification signature indicates correspondence to said media content type.

However, official notice is taken that these features are well known in the art and built-in to most of the media players existing at the time of the invention. One of the media players is Microsoft® Windows Media Player® (WMP), which features means for developing information specifying a media content type to be downloaded and saved/burned on CDs/DVDs of user's PC (see WMP help menu, Introducing WMP/Organizing your files/Adding items to your library), means for monitoring (see WMP help menu, Introducing WMP/Organizing your files/Adding items to your library/To add items to your library/Automatically add digital media files from folders

that you want the Player to monitor), means for analyzing content to capture content identification which are inherent to WMP to ensure compliance with Digital Rights Management (DRM) and means for recording and preserving content (e.g., burning a CD/DVD) for the purpose of facilitating the purchase and download of media content from the Internet to user's PC.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate these well-known features in Kloba for the purpose of facilitating the purchase and download of media content from the Internet to mobile devices.

Claim 15

The rejection of base claim 14 is incorporated. Kloba does not specifically disclose *wherein playing comprises:*

maintaining a pointer within said supplemental media content;

at selected points with said media content of said first selected pre-defined channel, playing a portion of said supplemental media content determined by said pointer while advancing said pointer

However, official notice is taken that these features are included in WMP (see at least WMP help menu, Using the Player/Using general playback controls/Playing files) for the purpose of facilitating the playback of media contents via the WMP interface.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the WMP features in Kloba for the purpose of facilitating the playback of media contents in Kloba.

Claim 21

The rejection of base claim 20 is incorporated. Kloba does not specifically disclose *playing media content of at:*

least one of said pre-defined channels;

receiving a command from said user to skip a portion of said media content;

skipping said portion of said media content and then resuming playing; and

transmitting information indicating said skipped portion to a remote monitoring site.

However, official notice is taken that these features are included in WMP (see at least WMP help menu, Using the Player/Using general playback controls/Playing files) for the purpose of facilitating the playback of media contents via the WMP interface.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the WMP features in Kloba for the purpose of facilitating the playback of media contents in Kloba.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

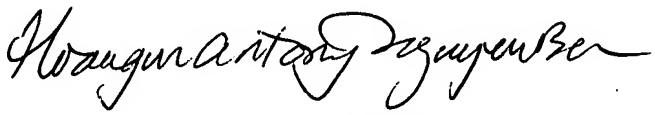
If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this

application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



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